



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,477	09/27/1999	CHARLES E. HILL	45607-65055	1650

25267 7590 02/27/2002

BOSE MCKINNEY & EVANS LLP
135 N PENNSYLVANIA ST
SUITE 2700
INDIANAPOLIS, IN 46204

EXAMINER

BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
----------	--------------

2165

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,477

Applicant(s)

HILL, CHARLES E. 

Examiner

Timothy M. Brown

Art Unit

2165

-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nc addr ss --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 have been examined.

Claim Rejections - Non-Statutory Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 8, 9 and 17-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 16, 29 and 36-38 of U.S. Patent No. 5,970,471. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claim 8 is equivalent to the subject matter claimed in claim 9 of the patent. Similarly, claim 9 in the application is equivalent to claim 16 of the patent, claim 17 in the application is equivalent to claim 29 of the patent, claim 18 in the application is equivalent to claim 36 of the patent, claim 19 in the application is equivalent to claim 37 of the patent and claim 20 in the application is equivalent to claim 38 of the patent.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2, 8, 9, 11, 17, 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. ✓ Claims 2 and 11 recite the limitation "the selected product category" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.

7. ✓ Each of claims 8 and 17 ✓ recite the limitation "the product images" in the first line of each of the claims. Each of claims 8 and 17 also recite "the product image" in the third line of each of the claims. Both "the product image" and "the product images" renders claims 8 and 17 indefinite because it is uncertain whether applicant is referring to the selected product image or to at least one of the plurality of product images.

8. ✓ Each of claims 9 and 18 ✓ recite the limitation "the product image" in the first line of each of the claims. "[T]he product image" renders claims 9 and 18 indefinite because it is uncertain whether applicant is referring to the selected product image or to at least one of the plurality of product images.

9. ✓ Claim 20 recites the limitation "the product image" in the first line of the claim. "[T]he product image" renders claim 20 indefinite because it is uncertain whether applicant is referring to the selected product image or to at least one of the plurality of product images.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

TB 11/13/02

11. ⁷ ~~Claims 1-8~~ ^{10-16 and 18} ~~are rejected~~ under 35 U.S.C. 103(a) as being unpatentable over ^{and} WIECHA (US 5,870,717) in view of CAMERON et al. (US 5,592,378).

Regarding claims 1 and 10, Weicha teaches a method and apparatus for presenting a plurality of product images for review by a user on a computer including a display, a memory, and an input device, the method and apparatus comprising: displaying a plurality of product images on the display (col. 3, lines 10-12 and 19-21); providing a side-by-side comparison of selected products (col. 3, lines 18-24); receiving a user input selecting a product image from the plurality of product images displayed on the display (col. 3, lines 18-19); and displaying the selected products for a side-by-side comparison with at least one other selected product (col. 3, lines 18-24).

Further regarding claims 1 and 10, Weicha does not specifically teach providing product image review boxes on the display for facilitating the side-by-side comparison of the product images. However Cameron et al. teach this limitation (see Figures 18 and 19). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, to include providing product review boxes for facilitating a

5

side-by-side comparison of selected product images because product review boxes would clearly segregate the selected items and provide a more user-friendly interface than that taught by Wiecha.

Regarding claims 2 and 11, Wiecha and Cameron et al. teach all the limitations discussed under claims 1 and 10 above. Further regarding claims 2 and 11, Wiecha does not specifically teach the displaying a plurality of product images by displaying a scroll box on the display which includes the plurality of product images from the selected product category. However, Cameron et al. teach the use of a product box to present a user with product names from the selected product category (col. 13, lines 64-67; col. 14, lines 1-6; and Figure 18). As for scrolling and the use of product images within the product box, Official Notice is taken that these limitations were notoriously well-known in the art of product display. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha with both Cameron et al.'s use of a product box for the display of products from a selected category, and the well-known concepts of the of scrolling and the use of product images in order to provide users with a easier means by which to browse and select products offered by vendors.

Regarding claims 3 and 12, Wiecha and Cameron et al. teach all the limitations discussed under claims 2 and 11 above. Further regarding claims 3 and 12, neither Wiecha nor Cameron et al. specifically teach displaying a plurality of product images wherein the product images in the review boxes are larger than the product images in the scroll box. However, Official Notice is taken that

this limitation was notoriously well-known in the art of product display at the time of the applicant's invention. One of ordinary skill in the art would have been motivated to modify the method taught by Wiecha and Cameron et al. to include displaying a plurality of product images that are larger than the product images in the scroll box because this combination would permit a user to quickly browse products contained within the scroll box.

Regarding claims 4 and 13, Wiecha and Cameron et al. teach all the limitations discussed under claims 1 and 10 above. Further regarding claims 4 and 13, Wiecha does not specifically teach displaying a plurality of product images wherein selected product images are displayed in the next available review box until all the review boxes are filled with product images, and wherein the next selected product image replaces the product image in one of the review boxes. However Cameron et al. teach this limitation (col. 13, lines 53-67; and col. 14, lines 1-21). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha to include a method of displaying a plurality of product images wherein selected product images are displayed in the next available review box until all the review boxes are filled with product images, and wherein the next selected product image replaces the product image in one of the review boxes. One of ordinary skill in the art would have been motivated modify Wiecha in this manner in order to allow a user to perform a side-by-side comparison of a greater number of products.

Regarding claims 5 and 14, Wiecha and Cameron et al. teach all the limitations discussed under claims 4 and 13 above. Further regarding claims 5 and 14, neither Wiecha nor Cameron et al. specifically teach presenting a plurality of product images wherein the user selects the review box in which to replace the product image after all the review boxes are filled with product images. However, the examiner takes Official Notice that selecting a review box in which replace a product image was notoriously well-known in the art of product display at the time of the applicant's invention. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha and Cameron et al., to include a step wherein the user selects a product review box in which to display the next-selected product image. One of ordinary skill in the art would have been motivated to modify Wiecha and Cameron et al. to allow a user to select a product review box for display of the next-selected item as this would allow the user to retain product images of interest for comparison with the next-selected product image.

Regarding claims 6 and 15, Wiecha and Cameron teach all the limitations discussed under claims 1 and 10 above. Further regarding claims 6 and 15, Wiecha further teaches receiving a user input to order a selected product displayed on the display, and automatically generating an order for the selected product (col. 3, lines 30-34).

Regarding claims 7 and 16, Wiecha and Cameron et al. teach all the limitations discussed under claims 6 and 15 above. Further regarding claims 7 and 16, Wiecha further teaches the step of automatically transmitting the order

form for the selected product from the computer to a vendor's computer located at a remote location (col. 3, lines 30-34).

12. **Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of CAMERON et al. (US 5,592,378) as discussed under claims 1 and 10 above, and further in view of MIZOKAWA (US 4,530,009).**

Wiecha does not specifically teach a method or apparatus wherein the product images include both a product image and a selected background image, and displaying the selected product image includes integrating the product image with a selected background image to provide a customized product image on the display. However, Mizokawa teaches this limitation (col. 3, lines 35-49; see *also* abstract). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, to include creating a customized product image as taught by Mizokawa because the addition of this step would allow a user to perform a side-by-side comparison of one or more customized product images whose components may vary based upon user input.

13. **Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of CAMERON et al. (US 5,592,378) and MIZOKAWA (US 4,530,009) as discussed under claims 8 and 17 above, and further in view of Gray et al. (US 4,661,811).**

Neither Wiecha, Cameron et al. nor Mizokawa specifically teach a method or apparatus wherein the product image and the selected background image are

integrated based on a map. However, Gray et. al teach this limitation (col. 1, lines 11-13; and col. 2, lines 20-36). The examiner takes Official Notice that transmitting a map or similar instructions to a user computer from a vendor's computer at a remote location was notoriously well-known in the art at the time of the applicant's invention. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, Cameron et al. and Mizokawa, to include the use of a map to integrate the product and background image wherein the map is transmitted from a remote location. Transmitting a map, from a remotely located vendor, for integrating the product and background images would allow a vendor to provide a suggested product composition thereby allowing the user to create a customized a product based upon a vendor's guidelines.

14. **Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of MIZOKAWA (US 4,530,009).**

Wiecha teaches an apparatus for displaying a product image for review by a user, the apparatus comprising: a computer including a display, a memory, and an input device (col. 3, lines 10-21); means for storing a plurality of product images in the memory of the computer (col. 3, lines 10-17; col. 5, lines 30-67; and col. 6, lines 1-25); means for storing a plurality of background images in the memory of the computer (col. 3, lines 10-17; col. 5, lines 30-67; and col. 6, lines 1-25); means for selecting one of the background images to be displayed on the display with each product image (col. 3, lines 18-34); and a means for receiving a user input to display a selected product image (col. 3, lines 10-34).

Wiecha does not specifically teach a means for integrating the selected product image with the selected background image on the display to provide a customized product image on the display. However, Mizokawa teaches this limitation (col. 3, lines 35-49; see *also* abstract). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha, to include a means for providing a customized product image as taught in Mizokawa as this would allow a user to create a customized product derived from components offered by a vendor.

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIECHA (US 5,870,717) in view of MIZOKAWA (US 4,530,009) as discussed under claim 19 above, and further in view of Gray et al. (US 4,661,811).

Neither Wiecha nor Mizokawa specifically teach an apparatus of wherein the product image and the selected background image are integrated by the integrating means based on a map. However, Gray et al. teach this limitation (col. 1, lines 11-13; and col. 2, lines 20-36). The examiner takes Official Notice that transmitting a map or similar instructions to a user computer from a vendor's computer at a remote location was notoriously well-known in the art at the time of the applicant's invention. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wiecha and Mizokawa, to include the use of a map to integrate the product and background image wherein the map is transmitted from a vendor at a remote location. Transmitting a map, from a remotely-located vendor, for the

purpose of integrating the product and background images, would allow a vendor to provide a suggested product composition thereby allowing the user to create a customized a product based upon a vendor's guidelines.

Conclusion

16. The following prior art not relied upon in this action is considered pertinent to applicant's disclosure and is hereby made of record:

- a. GOLDMAN (US 4,149,246) 10 April 1979; System for Specifying Custom Garments
- b. MAINE et al. (US 4,700,181) 13 October 1987; Graphics Display System
- c. WANATABE et al. (US 4,760,458) 26 July 1988; Image Processing System
- d. WALSH et al. (US 4,827,330) 2 May 1989; Automatic Document Image Revision
- e. FISHER et al. (US 4,833,625) 23 May 1989; Image Viewing Station for Picture Archiving and Communications Systems (PACS)
- f. VITEK et al. (US 4,845,634) 4 July 1989; Product Information Network System
- g. POCOCK et al. (US 4,905,094) 27 February 1990; System For Audio/Video Presentation
- h. SHERMAN (US 4,931,929) 5 June 1990; Design Component Selection Computer With Specification of Product Characteristics and of Color by Machine Readable Device

- i. NAHAN et al. (US 5,664,111) 2 September 1997; Computerized, Multimedia, Network, Real Time, Interactive Marketing and Transactional System
- j. SUBLER et al. (US 5,646,992) 8 July 1997; Assembly, Distribution, and Use of Digital Information
- k. MEIER et al. (US 5,196,838) 23 March 1993; Intelligent Scrolling
- l. HENSHAW et al. (US 5,485,174) 16 January 1996; Display Image Scroll Control and Method
- m. MILLER et al. (US 5,858,866) 17 December 1996; Electronic Television Program Guide Schedule System and Method Including Virtual Channels
- n. WESTROPE et al. (US 5,721,832) 24 February 1998; Method and Apparatus For an Interactive Computerized Catalog and System
- o. MAROTEAUX et al. (US 5,544,303) 6 August 1996; Method for Configuring and Operating a Telecommunication Apparatus
- p. MCCALLEY et al. (US 4,792,849) 20 December 1988; Digital Interactive Communication System
- q. MUELLER et al. (US 5,235,509) 10 August 1993; Customer Self-Ordering System Using Information Displayed On a Screen
- r. GARDNER et al. (US 5,758,327) 26 May 1998; Electronic Requisition and Authorization Process
- s. KING JR. et al. (US 5,319,542) 7 June 1994; System For Ordering Items Using An Electronic Catalog

- t. CHELLIAH et al. (US 5,710,887) 20 January 1998; Computer System and Method for Electronic Commerce
- u. SMUTEK et al. (US 4,553,206) 12 November 1985; Image Storage and Retrieval
- v. SCHMITZ (US 4,500,875) 19 February 1985; Device For Displaying Digital Information Incorporating Selection of Picture Pages and/or Resolution Enhancement
- w. GUMP et al. (US 5,142,662) 25 August 1992; Electronic Publishing System
- x. Thomas, M., *Graphics Tools is low-cost, hearty image manager*, *InfoWorld*, Vol. 15, no. 41 (October 11, 1993) p. 80
- y. *Multimedia authoring software; multimedia for the masses*, *InfoWorld*, Vol. 18, no. 4 (January 22, 1996) p. 64
- z. INTERGRAPH CORP 2: *Intergraph introduces two rendering products for a range of users: ModelView Advantage, ModelView Professional* (March 13, 1995)
- aa. Marhsall, P., *Photostyler: Version 2.0*, *InfoWorld*, Vol. 16, no. 25 (June 20, 1994) p. 77
- bb. Glass, B., *Dress up your VB apps*, *InfoWorld*, Vol. 17, no. 18 (May 1, 1995) p. 74

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Brown whose telephone number


is (703) 305-1912. The examiner can normally be reached on Monday - Friday,
8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The
fax phone numbers for the organization where this application or proceeding is
assigned are (703) 746-7239 for regular communications and (703) 746-7238 for
After Final communications.

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
(703) 305-3900.

Timothy M. Brown
Examiner
Art Unit 2165

TMB
February 21, 2002


WYNN COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100